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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,736	05/31/2002	Deuk Hun Ahn	SAM01830	8289
43569	7590	08/05/2005	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			MCCORMICK EWOLDT, SUSAN BETH	
			ART UNIT	PAPER NUMBER
			1655	

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,736

Applicant(s)

AHN ET AL.

Examiner

S. B. McCormick-Ewoldt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5 and 6 is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment of June 7, 2005 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims Pending

Applicant has cancelled claim 4 and has added claims 7-11. Claims 1-3 and 5-11 will be examined on the merits.

Claim Objections

Claims 2 and 8 are objected to because of the following informalities: claims 2 and 8 are grammatically improper sentences, as the term "comprising" should read --comprises--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claims 9-10, the claims do not recite the required ingredient of *Artemisia folia*.

Claim Rejections - 35 USC § 103

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn *et al.* and Whittle (US 5,466,452).

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Ahn *et al.* disclose using *Galla rhois*-derived material to inhibit growth on certain bacteria (see page 442, col. 2, lines 4-7 and 17-21). Ahn *et al.* did not specifically teach using of *Galla Rhois* for the use in sanitary napkins.

Whittle (US 5,466,452) discloses that *Sophora flavescens* is used as an antimicrobial agent (TABLE 1).

The references taken together teach that *Galla rhois* inhibits the growth of certain bacteria and that *Sophora flavescens* is used as an antimicrobial agent as cited by the references. Based on the teaching of the references, it was known in the art at the time of the invention that *Galla rhois* and *Sophora flavescens* are used as antimicrobial agents. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the herbal agents discussed above for the following reasons. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose, in this case, antibacterial agents in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Sussman*, 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn *et al.* and Whittle as applied to claim 7 above, and further in view of Tsai *et al.* and Fahim *et al.* (US 5,877,298).

As discussed above Ahn and Whittle disclose that *Galla rhois* and *Sophora flavescens* are used as antimicrobial agents. Tsai *et al.* teach using the herb, *Phellondendri cortex*, as an herbal

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medicine in a composition because of the antibacterial and anti-inflammatory properties it contains (col. 8, lines 60-67 and col. 9, lines 1-8 and col. 14, lines 45-47).

Fahim *et al.* (US 5,877,298) disclose that alum is routinely used as an adjuvant to enhance compositions (column 11, lines 16-20).

The references taken together teach that *Galla rhois*, *Sophora flavescens* and *Phellondendri cortex* are used as antimicrobial agents as cited by the references. Based on the teaching of the references, it was known in the art at the time of the invention that *Galla rhois*, *Sophora flavescens* and *Phellondendri cortex* are used as antimicrobial agents. The use of alum is known in the art as routinely used as adjuvants. Based on this reasonable expectation of beneficial results, an artisan of ordinary skill would have been motivated to modify Ahn, Whittle and Tsaito include *Galla rhois*, *Sophora flavescens* and *Phellondendri cortex* to be used in an antibacterial composition suitable for sanitary napkins.

The references also do not specifically teach the ingredients in the amounts claimed by Applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn *et al.*, Whittle, Tsai *et al.* and Fahim *et al.* as applied to claims 7-8 above and further in view of Blank *et al.* (US 5,079,004).

As discussed above, the combination of Ahn, Whittle, Tsai teaches the claimed composition using *Galla rhois*, *Sophora flavescens* and *Phellondendri cortex* as antimicrobial agents. Fahim discloses that alum is routinely used as an adjuvant to enhance compositions. However, the references do not teach that *Galla rhois*, *Sophora flavescens*, *Phellondendri cortex* and alum be used in a composition for use on a sanitary napkin. It is known in the art that

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antimicrobial agents can be employed in sanitary pads because of the ideal environment for microbial growth. Blank *et al.* (US 5,079,004) discloses that it was known in the pharmaceutical art to employ antimicrobial agents for the benefit of odor reduction and control of microbes, rashes and allergies (column 1, lines 17-26). Blank *et al.* teach that sanitary pads can contain an ideal environment for microbial growth and an antimicrobial agent can be incorporated in the composition to which is added to the sanitary pad (column 4, lines 52-60; column 7, lines 61-64). Thus it was known at the time of the invention that antimicrobial agents are added to sanitary napkins. A person of ordinary skill in the art would reasonably expect that using antimicrobial agents on sanitary napkins would expect beneficial results. Based on this reasonable expectation of success, an artisan of ordinary skill in the art would be motivated to add *Galla rhois*, *Sophora flavescens*, *Phellondendri cortex* and alum to sanitary napkins.

The references also do not specifically teach the ingredients in the amounts claimed by Applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

Therefore, with the showing of the references, the burden of establishing non-obviousness by objective evidence is shifted to the Applicant.

Summary

Claims 1-3, 5, 6 are free of the prior art and are allowable because the prior does not teach or suggest combining *Galla rhois* and *Artemesia folia* together.

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Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

Susan D. Coe
8-2-05
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PRIMARY EXAMINER